

D1
Cart
-- 48. The recombinant adenovirus expression vector of claim 38, wherein the vector is A/C/N/53.--

-- 49. The recombinant adenovirus expression vector of claim 38, wherein the vector is A/M/N/53. --

REMARKS

Claims 1-3, 6-15, and 32-27 are currently pending in this application and have been examined on the merits. Without acquiescing to the Examiner's position and in the interest of expediting prosecution, Applicants have canceled claims 1, 3, 6, 8-12, and 32-37. Applicants reserve the right to pursue the subject matter of these canceled claims in a continuation, continuation-in-part, divisional, or other related case. Furthermore, cancellation of any subject matter in no manner represents abandonment of that subject matter.

The dependencies in claims 7 and 13-15 have been amended to reflect the newly added claims 38-49. Support for these claims can be found throughout the specification, especially p.13, line 13, through p. 14, line 25; p.. 6, lines 15- 27; and p. 18, lines 24-26.

Rejections under 35 U.S.C. 102(a)

Claims 32-33 and 35-37 have been rejected under 35 U.S.C. 102(a) as being anticipated by Bacchetti et al. (Inter. J. Oncol. 3:781-188 (1993)). Without acquiescing to the Office's position and in the interest of further expediting prosecution, Applicants have canceled these claims, thereby obviating the rejection.

Applicants see no reason that this reference would be applied to the remaining claims but nevertheless respectfully point out that should this reference be applied to the remaining claims, that Bacchetti and Graham do not disclose an adenovirus vector in which all or part of protein IX has been deleted.

77

Rejections under 35 U.S.C. 102(b)

Claims 1, 3, 7, 8, 10, and 12-14 have been rejected under 35 U.S.C. 102(b) as being anticipated by Haj-Ahmad et al. (J. Virol. 57:267-274 (1986)). Without acquiescing to the Office's position and in the interest of further expediting prosecution, Applicants have canceled these claims, thereby obviating the rejection.

Applicants respectfully point out that the newly added claims do not use the language "about 4000 bp", but rather, specify that the deletion begin at nucleotide 327 and end at nucleotide 4020 to 4050. Applicants further respectfully point out that both the canceled and newly added claims require that the inserted DNA be heterologous, as in the case of a tumor suppressor gene; the section cited by the Examiner in Haj-Ahmad at p. 272, second paragraph of the discussion, did not disclose whether a heterologous DNA segment had been inserted into the vector.

Rejections under 35 U.S.C. 103

Claims 6 and 9 have been rejected under 35 U.S.C. 103(a) as unpatentable over Haj-Ahmad et al. in view of Winnaker (From Genes to Clones, pp. 343-343, VCH Publishers, NY). Claims 11 and 15 have been rejected under 35 U.S.C. 103 as being unpatentable over Haj-Ahmad et al. in view of Bacchetti et al. As claims 6, 9, and 11 have been canceled, the rejection of these claims is obviated. Applicants respectfully traverse this rejection as it applies to claim 15.

Applicants respectfully point out that claim 15 has been amended to depend from claim 38, thereby incorporating all the elements of claim 38. As discussed above, the claimed deletion was not disclosed or suggested by Haj-Ahmad et al. or Bacchetti and Graham. Applicants thus request withdrawal of this rejection of claim 15 under 35 U.S.C. 103.

Claims 32-37 have been rejected under 35 U.S.C. 103 as unpatentable over Haj-Ahmad et al., as applied to claims 6, 9, 11, and 15 and further in view of Casey et al. (Oncogene 6:1791-

1797 (1991)). As these claims have been canceled the rejection is obviated.

Rejections under 35 U.S.C. 112, second paragraph

Claims 1,3, and 6-15 have been rejected under 35 U.S.C. 112, second paragraph, as indefinite. Specifically, the Examiner has objected to the language "about". Without acquiescing to the Examiner's's position and in the interest of further expediting prosecution, Applicants have canceled certain claims and added certain new claims in which this language does not appear. Applicants thus request that this rejection of the remaining claims be withdrawn.

Rejections under 37 C.F.R. 1.75(c)

Claim 7 has been objected to under 37 C.F.R. 1.75 (c) as being in improper form. As Applicants have amended claim 7 to depend from a single claim, this rejection is overcome.

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would be helpful, please telephone the undersigned at (415) 326-2400.

Respectfully submitted,



Renee A. Fitts
Reg. No. 35,136

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
(415) 326-2400
Fax (415) 326-2422